

### REMARKS

The present Office Action addresses and rejects claims 61-69, 72-89, and 95. Applicants respectfully request reconsideration in view of the amendments and remarks herein.

#### *Effective Filing Date of Claims*

The Examiner states that claims 61-67, 72, 75, 76, 82, 84, and 95 have an effective filing date of July 3, 1997 and that claims 68, 69, 73, 74, 77-81, 83, and 85-89 have an effective filing date of November 21, 1997. Applicants respectfully disagree.

Claims 61-68, 75-76, 82-83, and 95 are supported by U.S. Application No. 08/754,566 filed November 21, 1996 ("the '566 application") to which the current application claims priority. Accordingly, the effective date for these claims is November 21, 1996. Similarly, claims 72 and 84 are supported by U.S. Application No. 08/887,580 filed July 3, 1997 ("the '580 application") to which the current application also claims priority. Accordingly, the effective date for these claims is July 3, 1997. The following table details the supporting disclosure for each claim:

Claim	The '566 Application (11/21/1996)	The '580 Application (7/3/1997)
61	p. 4, l. 10 - p. 5, l. 8 and Figures 1B-4D	
62	p. 4, ll. 10-15	
63	p. 4, ll. 17-18	
64	Figure 3	
65	Figure 3	
66	p. 9, ll. 25-29	
67	p. 10, ll. 5-11	
68	Figures 3-4D	
72		p. 4, l. 10 - p. 5, l. 17
75	p. 4, l. 10 - p. 5, l. 8 and Figures 1B-4D	
76	p. 7, ll. 12-19	
82	p. 5 ll. 5-8	
83	p. 8, ll. 25-26, FIG. 4A-4D	
84		p. 4, l. 10 - p. 5, l. 17
95	p. 4, l. 10 - p. 5, l. 8, p.9, ll. 25-29; and Figures 1B-4D	

### *Amendments to the Claims*

Applicants amend claims 61, 75, 84, and 95 to recite pulling the distal end of the insertion element into the proximal end of the stabilizing element. Support for these amendments can be found throughout the specification and drawings, for example in paragraphs [0049]-[0053] and FIGS. 5A-6. No new matter is added. Since amended claim 61 is substantially the same as previously presented claim 72, Applicants cancel claim 72. Applicants also cancel claims 69, 73-74, 77-81, and 85-89 in order to expedite prosecution, reserving the right to pursue these claims in a divisional application.

### *Claim Rejections Pursuant to 35 U.S.C. § 103(a) – Nicholson and Goble*

Claims 61-69, 75-83, and 95 are rejected pursuant to 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 5,725,529 (“Nicholson”) in view of U.S. Patent No. 4,870,957 (“Goble”). Applicants respectfully disagree.

Independent claims 61, 75, and 95 each recite, in relevant part, pulling the distal end of an insertion element into the proximal end of a stabilizing element. Nicholson is deficient with respect to claims 61, 75, and 95 because, as acknowledged by the Examiner on page 3 of the Office Action, it fails to teach or even suggest pulling the distal end of an insertion element into the proximal end of a stabilizing element. Instead, the insertion element (34) of Nicholson is pushed into the expandable element (10). *See Nicholson* at FIG. 10.

Goble fails to remedy this deficiency in Nicholson because it too lacks any teaching of pulling the distal end of an insertion element into the proximal end of a stabilizing element. Instead, as shown in Figure 1 of Goble, the stud (10) is pushed into the threaded footing (11), not pulled as claimed.

Accordingly, claims 61, 75, and 95 are not obvious over Nicholson or Goble, taken alone or in combination. Claims 61, 75, and 95 thus represent allowable subject matter and claims 62-68, 76, and 82-83 are allowable at least because they depend from allowable base claims.

***Claim Rejections Pursuant to 35 U.S.C. § 103(a) – Nicholson, Goble, Pierce, and Le***

Claims 72-74 and 84-89 are rejected pursuant to 35 U.S.C. § 103(a) as being obvious over Nicholson in view of Goble and further in view of U.S. Patent No. 5,324,308 ("Pierce") or U.S. Patent No. 5,486,197 ("Le"). Applicants respectfully disagree. Since claim 61 has been amended to substantially conform with now-canceled claim 72, the rejections of claim 72 are discussed below with respect to amended claim 61.

Independent claims 61 and 84 each recite, in relevant part, pulling the distal end of an insertion element into the proximal end of a stabilizing element. The Examiner concedes that both Nicholson and Goble fail to teach or suggest pulling the insertion element into the stabilizing element, and relies on Pierce or Le to remedy this deficiency. The Examiner argues that both Pierce and Le teach utilizing pulling forces and sutures in order to insert core elements into their outer sheaths. *Office Action* at 3. The method as claimed however requires pulling the distal end of the insertion element into the proximal end of a stabilizing element, not merely "utilizing pulling forces" as suggested by the Examiner.

Pierce fails to remedy the deficiencies in Nicholson and Goble because it lacks any teaching to pull the distal end of an insertion element into the proximal end of a stabilizing element. As illustrated in Figure 1 of Pierce, a bone anchor is disclosed that includes a proximal wedge (14) and a distal wedge (15) threaded over a guide wire (13). As shown in Figure 20 of Pierce, a suture (B) can be threaded through the distal wedge (15) to apply tension thereto in the proximal direction while the proximal wedge (14) is pushed distally against the distal wedge (15). Pierce thus teaches pulling the proximal end of the first wedge (15) towards the distal end of the second wedge (14) – the exact opposite of what is claimed. Moreover, the claimed methods require that the insertion element be pulled *into* the stabilizing element. No part of the distal wedge (15) of Pierce is drawn *into* the proximal wedge (14). Rather, as the Pierce wedges (14, 15) come together, they only cam over each other as shown in Figure 29. Pierce thus fails to remedy the deficiencies in Nicholson and Goble.

Le likewise fails to remedy the deficiencies in Nicholson and Goble for much the same reasons as Pierce. As shown in Figures 9-10 of Le, the only use of pulling force disclosed is pulling a ball (6) proximally into the distal end of an anchor body (1). Like Pierce, this is the exact opposite of what is claimed. Merely reversing the distal/proximal perspective of Le does not resolve its deficiencies because Le is only disclosed as being used in a blind-hole, and therefore reversing its orientation would render the device inoperable as there would be no way to access and pull the suture in the distal direction. Without a through-hole to provide access to both ends of the device, it would be impossible to pull the distal end of the Le ball (6) into the proximal end of the anchor body (1), as is required by the claims. Applicants further note that Le expressly teaches away from the use of a through-hole at col. 1, ll. 33-47, where numerous perceived disadvantages to through-holes are set forth. Le thus fails to remedy the deficiencies in Nicholson and Goble.

Accordingly, neither Pierce nor Le remedy the deficiencies in Nicholson and Goble with respect to claims 61 and 84. These claims are therefore not obvious over Nicholson, Goble, Pierce, or Le, taken alone or combined, and thus represent allowable subject matter. Claims 62-68 are allowable at least because they depend from an allowable base claim.

***Claim Rejections Pursuant to 35 U.S.C. § 103(a) – Eaton, Treace, Parr, and Goble***

Claims 73-74 and 85-88 are rejected pursuant to 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 5,871,504 ("Eaton") in view of either U.S. Patent No. 3,953,896 ("Treace"), U.S. Patent No. 4,744,793 ("Parr"), or Goble. While Applicants respectfully disagree, claims 73-74 and 85-88 are canceled in order to expedite prosecution, thereby obviating the Examiner's rejection.

***Co-pending Applications***

The Examiner requests that Applicants disclose a list of all co-pending applications that set forth similar subject matter to the present claims. At this time, no such applications exist.

***Conclusion***

Applicants submit that all claims are in condition for allowance, and allowance thereof is respectfully requested. Applicants' amendment of the claims does not constitute a concession that the claims are not allowable in their unamended form. The Examiner is encouraged to telephone the undersigned attorney for Applicants if such communication is deemed to expedite prosecution of this application.

Respectfully submitted,

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